

### **REMARKS/ARGUMENTS**

Applicants have reviewed and analyzed the Office Action dated February 1, 2008, and provide the following remarks and comments in response thereto. Claims 20-25, 36 have been cancelled. Claims 1, 3-5, 7, 8, 10, 11, 13-15, 17-19, 26, 28-30 and 32-34 have been amended. Claims 37 and 38 have been added. No new matter has been added. Claims 1-19, 26-34, 37 and 38 are pending upon entry of the present amendment.

#### ***Claim Objections***

Claims 7, 30, 31, 34 and 36 stand objected to under 37 C.F.R. §1.75. Claims 7, 30, 31 and 34 have been amended and claim 36 has been cancelled. Accordingly, Applicants respectfully traverse this rejection.

#### ***Claim Rejections Under 35 U.S.C. §101***

Claims 26-34 stand rejected under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter. In particular, the Office Action notes that the Specification, at p. 8, describes computer readable media as encompassing statutory media such as ROM, hard drives, optical drives as well as non-statutory subject matter such as a signal. Without addressing the validity of this assertion, Applicants respectfully note that claim 26 is directed to a machine readable **storage** medium, not computer readable media. Thus, even if the assertion is taken as valid, the asserted definition does not relate to machine readable storage media. Accordingly, Applicants traverse this rejection.

#### ***Claim Rejections Under 35 U.S.C. §102***

Claims 1-7, 9-16, 18, 19, 26-31, 33 and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable by Reynolds *et al.* (U.S. Patent Pub. No. 2001/0037500, "Reynolds") in view of Kaiser *et al.* (U.S. Patent No. 6,615,408, "Kaiser"). This rejection is respectfully traversed.

Amended independent claim 1 recites, *inter alia*, a set-top box configured to receive a signal configured to modify a first priority indicator of a broadcast stream from a first priority to a second priority and to modify the first priority indicator from the first priority to the second priority in response to receiving the signal. Reynolds fails to teach or suggest such features. In



particular, nowhere does Reynolds or Kaiser, either separately or in combination, teach or suggest a signal received at a set top box that is configured to modify a first priority indicator associated with a broadcast stream. Reynolds describes extracting meta data from a video broadcast signal and determining a priority level associated with the meta data. However, there is still no teaching or suggestion in Reynolds of modifying the priority level in response to receiving a signal configured to make the modification. Kaiser fails to cure these deficiencies of Reynolds. Accordingly, claim 1 is allowable for at least these reasons.

Amended independent claims 11 and 26 recite features similar to those discussed with respect to claim 1 and are thus allowable for at least the same reasons as claim 1 and further in view of the novel and non-obvious features recited therein.

Claims 2-7, 9, 10, 12-16, 18, 19, 27-31, 33 and 34 are dependent on claims 1, 11 and 26, respectively, and are thus allowable for at least the same reasons as their base independent claim. Additionally, with respect to claim 7, the Office Action asserts that, inherently, Reynolds must have a sync signal (time mark) within the broadcast stream so that the system will be able to synchronize the insertion of the second media with the broadcast stream. Applicants disagree. Applicants note that the fact that a certain result or characteristics may occur or be present in the prior art is **NOT** sufficient to establish the inherency of that result or characteristics. MPEP § 2112(IV) (citing *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (emphasis added). Indeed, to establish inherency, “the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). There is no teaching or suggestion in Reynolds to suggest that a signal to change the first priority indicator being programmed by a time mark is necessary to Reynolds’ method and system. Accordingly, claim 7 is allowable for this additional reason.

Additionally, in the Office Action’s rejection of claims 6 and 16, the Office Action takes Official Notice that notification of an e-mail message is notoriously well known in the art. Even assuming, without conceding, that the asserted Official Notice is valid, the asserted taking of Official Notice does not cure the above identified deficiencies of claims 1 and 11, upon which claims 6 and 16 depend, respectively. Accordingly, claims 6 and 16 are allowable for at least these reasons.



Claims 20-25 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reynolds in view of Zigmond *et al.* (U.S. Patent No. 6,698,020, “Zigmond”). These claims have been cancelled, rendering this rejection moot.

Claims 8, 17 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reynolds in view of Kaiser and further in view of Bullock *et al.* (U.S. Patent No. 5,070,404, “Bullock”). Applicants respectfully traverse this rejections for at least the following reasons.

Claims 8, 17 and 32 are dependent on claims 1, 11 and 26, respectively, and are thus allowable over Reynolds and Kaiser for at least the same reasons as their base independent claims. Bullock fails to cure the deficiencies of Reynolds and thus, notwithstanding whether the asserted combination of Reynolds, Kaiser and Bullock is proper, claims 8, 17 and 32 are also allowable over the asserted combination.

#### ***New Claims***

Claims 37 and 38 have been added. Claims 37 and 38 depend on claim 1 and are thus allowable for at least the same reasons as claim 1.



**CONCLUSION**

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the Examiner is requested to contact the undersigned at (202) 824-3156.

Respectfully submitted,  
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